

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of :  
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Koichiro TANI : Confirmation No. 2067  
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Serial No. 10/673,258 : Group Art Unit: 3761  
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Filed: September 30, 2003 : Examiner: Melanie Jo Hand  
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For: DISPOSABLE DIAPER

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Attn: BOARD OF PATENT APPEALS AND INTERFERENCES

**SECOND REPLY BRIEF UNDER 37 C.F.R. § 41.41**

Appellant hereby files this reply brief to the Supplemental Examiner's Answer mailed October 15, 2008.

Appellant respectfully traverses all Examiner's arguments indicated in the "Response to Argument" section of the Supplemental Examiner's Answer. In the following ARGUMENT section, Appellant will address the Examiner's arguments indicated in the "Response to Argument" section *only*. Any remaining issues are believed to have been sufficiently and adequately treated in the Appeal Brief filed January 23, 2008 and the Reply Brief filed July 30, 2008.

**STATUS OF CLAIMS**

**A. Total Number of Claims in Application**

There is a total of 19 claims in the application, which are identified as claims 1, 3-5, 7-10, 12-13, 15, 17, 19-20, 22-26.

**B. Status of all the claims**

1. Claims cancelled: claims 2, 6, 11, 14, 16, 18, 21
2. Claims withdrawn from consideration but not cancelled: none
3. Claims pending: claims 1, 3-5, 7-10, 12-13, 15, 17, 19-20, 22-26
4. Claims allowed: none
5. Claims rejected: claims 1, 3-5, 7-10, 12-13, 15, 17, 19-20, 22-26

**C. Claims on Appeal**

Claims on appeal are claims 1, 3-5, 7-10, 12-13, 15, 17, 19-20, 22-26 as rejected by the Final Office Action dated August 22, 2007.

**GROUND OF REJECTION TO BE REVIEWED ON APPEAL**

The 35 U.S.C. 103(a) rejection of all claims on appeal as being unpatentable over *Robles* (U.S. Patent No. 6,004,306).

## ARGUMENT

### *35 U.S.C. 103(a) rejection of all claims on appeal as being unpatentable over Robles*

#### Claim 1

The Examiner's response to Appellant's arguments is noted.

First, the Examiner insisted <sup>1</sup> that the newly cited section of *Robles*, i.e., column 23 lines 32-43, is applicable against the claimed invention, because it does not distinguish between external bonds (that bond extensible side panels 30 to the diaper main body) and internal bonds (that create extensibility of extensible side panels 30). Appellant respectfully disagrees, because the cited section is clearly directed *only to internal bonds* as highlighted immediately below:

Alternatively, the extensible side panel 30 can be constructed out of extensible materials having areas of different elastic behavior achieved by means other than the aforementioned mechanical operations, such as slitting, cutting, bonding or folding the extensible material that forms the extensible side panel. In such embodiments, the slits, folds, bonds or cuts in the material are not limited to any particular sizes or shapes. For example, the material making up the extensible side panel 30 may be fully or partially severed or may have portions cut out or bonded to create different extensibility characteristics in the extensible side panel 30.

The Examiner also alleged that "external bonds can create different extensibility characteristics as effective as internal bonds within the side panels 30." Appellant respectfully disagrees, because *Robles* do not teach or suggest such. The reference, as discussed *supra*, only discloses that internal bonds may create extensibility for the side panels 30. No where in the whole disclosure of *Robles* does the reference teach or suggest that the external bonds that bond side panels 30 to the diaper main body can create extensibility for the side panels 30 as alleged in the Supplemental Examiner's Answer.

Second, the Examiner insisted <sup>2</sup> that the *Robles*'s teaching of "intermittent bonds" meet the claim feature of a bonding-free region in the width direction. Appellant respectfully maintains the position detailed in the Appeal Brief and the first Reply Brief that there is no

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<sup>1</sup> Supplemental Examiner's Answer, at page 3, the second full paragraph from bottom.

<sup>2</sup> Supplemental Examiner's Answer, at page 3, the last full paragraph.

evidence in *Robles* that adjacent bonded regions are spaced from each other in the width direction as presently claimed. The obviousness reasoning given in the Supplemental Examiner's Answer, i.e., "one of ordinary skill in the art would certainly consider the intermittent bonding disclosed by *Robles* to be referring to bonding regions spaced apart in both directions, and certainly at least in the width direction as this is the direction of extension force applied by the user and the primary intended direction of extension of the extensible side panels 30...." is improper as *Robles* does not give any hint as to any relationship between the external bonds of the extensible side panels 30 to the diaper body and its extensibility or direction of extension.

Appellant respectfully submits that, given the spacing in the longitudinal direction between the reference's bonding sites (near 72 and 78 in FIG. 3), a person of ordinary skill in the art would consider the *Robles* "intermittent" bonding teaching as directed to bonding sites that are spaced in the longitudinal direction, rather than in the width direction as presently claimed. There is no clear reason(s)<sup>3</sup> why the person of ordinary skill in the art would have considered "intermittent" bonding in the width direction as proposed in the Supplemental Examiner's Answer.

For any of the reasons presented above and in the Appeal Brief and the first Reply Brief, the obviousness rejection of claim 1 is improper and should be withdrawn.

#### Claim 17

Appellant notes that the Examiner has not specified why the claimed step of adjusting positions of the fixing and joining parts would have been obvious over the prior art teaching.

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<sup>3</sup> Rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *KSR International Co. v. Teleflex Inc.*, 550 U.S. at \_\_\_, 82 USPQ2d at 1396.

Claims 19, 20, and 22-23

These claims are separately patentable from each other and from other claims in the group for the reasons detailed in the Appeal Brief and the first Reply Brief, and further for the reasons detailed above with respect to claim 1.

Claim 24

The Examiner's additional argument about "upper part" and "lower part" is not understood.

Appellant's argument in the first Reply Brief (page 8) was directed to other features which were not responded to by the Supplemental Examiner's Answer.

Claim 25

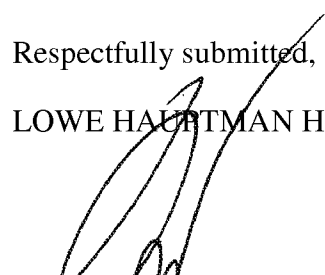
As to claim 25, Appellant respectfully maintains the previously presented position that there is no reasonable interpretation of *Robles* (especially FIG. 2) as teaching or suggesting *both* that "an entirety of the fastener is co-elevational in the longitudinal direction with the bonding-free region's section that separates the first and second joint parts in the longitudinal direction" (as recited in claim 25) and that "the fastener is not co-elevational in the longitudinal direction with any portion of the first joint part and the second joint part" (as recited in claim 24 from which claim 25 depends).

Consideration of this Second Reply Brief together with the previously submitted Appeal Brief and Reply Brief is respectfully requested. Reversal of the Examiner's Final Rejection, in view of the arguments presented in the previously submitted Appeal Brief and Reply Brief, as well as in this Second Reply Brief, is believed appropriate and therefore courteously solicited.

If for any reason this Second Reply Brief is found to be incomplete, or if at any time it appears that a telephone conference with counsel would help advance prosecution, please telephone the undersigned, Appellant's attorney of record.

Respectfully submitted,

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**Date: December 15, 2008**